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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,414	04/21/2002	Sharon Flank	08228/1203278-US5	9904

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EXAMINER	
COBY, FRANTZ	

ART UNIT	PAPER NUMBER
2161	

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/063,414	FLANK ET AL.	
	Examiner	Art Unit	
	Frantz Coby	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This is in response to Applicant's Request for Continuing Examination (RCE) filed on April 21, 2006 in which claims 1, 4, 7, 10 were amended and claims 16-17 were added.

Status of Claims

Claims 1-17 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai et al. U.S. Patent no. 6,0.72,904 in view of Schultz U.S. Patent no. 5,721,902 and further in view of Voorhees et al. U.S. Patent no. 5,864,845.

As per claims 1, 16-17, Desai et al. disclose "a method for use with a system storing

digital media records and comprising a search engine searching said stored digital media records, the method comprising the steps of: receiving search requests from users; logging the search requests, using a semantic net hierarchy, a lowest-level term in the hierarchy that subsumes all of the queries in a grouping of search requests', communicating the identified term to a user" by providing a graphical based image retrieval system (See Desai et al. Abstract, Col. 2, lines 22-38., Col. 4, lines 34-60; Col. 5, lines 56-63). The applicant should duly note that in Desai, user expressions of interest are expressed as image (query) that a user has interest in finding and is entered to be compared against clusters of images stored in the database.

It is noted, however, Desai et al. did not specifically detail the aspect of "expanding the search requests" as recited in the instant claims 1 , 4, 7 and 10. On the other hand, Schultz achieved the aforementioned limitations by providing an expansion of query terms using part of speech tagging (See Schultz Title, Abstract).

It would have been obvious to one of ordinary skill in the ad at the time of the invention to modify image retrieval system of Desai et al. by incorporating, in the search mechanism of Desai et al. the query expansion method of Schultz. The motivation being

to provide a searching/retrieval system which can query a library or database and identify not only text documents, but also multi-media files stores on the library of database that are relevant to the query (See Schultz Col. 2, lines 57-61).
It is further noted, that neither Desai nor Schultz specifically detail the aspects of "applying a statistical clustering algorithm, thereby grouping similar search requests together based on content of the expanded logged search requests" as recited in the recited claim. Voorhees et al. however, disclose the aforementioned claimed futures by providing a system for World Wide Web searches utilizing a multiple search engine query clustering strategy (See Voorhees et al. Title; Abstract', Col. 2, line 17-Col. 4, line 50).

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modified the combination to Desai and Shultz above by incorporating the mechanism for query clustering disclose by Voorhees into the combined searching/retrieval system of Desai/Schultz. The motivation being to provide a search retrieval system for combining the results of separate search engines into a single integrated ranked list of pages in response to a query. Thereby, improved the effectiveness of a single text retrieval system despite the collection being physically separated (See Voorhees Col. 1 , line 60-Col. 2, line 22).

As per claims 4, 7 and 10, all the limitations of these claims have been noted in the rejection of claims 1, 16-17. They are therefore rejected as set forth above.

As per claims 2-3, most of the limitations of these claims have been noted in the rejection of claims 1, 16-17. Applicant's attention is directed to the rejection of claim 1 above. In addition, Schultz discloses the claimed features of "wherein the expanding is performed using a thesaurus "wherein the expanding is performed using a semantic net comprising synonyms and super-terms" (See Schultz Figures 4A-4C) especially "Thesaurus" and "Dictionary".

As per claims 5-6, most of the limitations of these claims have been noted in the rejection of claims 4, 7 and 10. Applicant's attention is directed to the rejection of claim 4 above. In addition, Schultz discloses the claimed features of "wherein the expanding is performed using a thesaurus', "wherein the expanding is performed using a semantic net comprising synonyms and super-terms" (See Schultz Figures 4A-4C) especially "Thesaurus" and "Dictionary".

As per claims 8-9, most of the limitations of these claims have been noted in the rejection of claims 4, 7 and 10. Applicant's attention is directed to the rejection of claim 7 above. In addition, Schultz discloses the claimed features of "wherein the expanding is performed using a thesaurus"' "wherein the expanding is performed using a semantic net comprising synonyms and super-terms" (See Schultz Figures 4A-4C) especially "Thesaurus" and "Dictionary".

As per claims 11-12, most of the limitations of these claims have been noted in the rejection of claim 10. Applicant's attention is directed to the rejection of claim 10 above. In addition, Schultz discloses the claimed features of "wherein the expanding is performed using a thesaurus', "wherein the expanding is performed using a semantic net comprising synonyms and super-terms" (See Schultz Figures MAMC) especially "Thesaurus" and "Dictionary".

Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai et al. U.S. Patent no. 6,072,904 in view of Schultz U.S. Patent no. 5,721 ,902 and Voorhees et al. U.S. Patent 5,864,845 and further in view of Wiser et al. U.S. Patent no. 6,385,596.

As per claims 13-15, most of the limitations of these claims have been noted in the rejection of claim 10 above. Applicant's attention is directed to the rejection of claim 10.

It is noted, however, neither Desai et al. nor Schultz disclose the aspects of "wherein a user expressing interest in a selected 'digital media record comprises the user placing the selected digital media record into an online shopping cad"; "wherein a user expressing interest in a selected digital media record comprise: the user purchasing rights to use the selected digital media record', 'wherein a user expressing interest in a selected digital media record comprises the user placing the selected digital media record into an online projects folder or other work space". On the other hand,

Wiser achieved the aforementioned claimed features by providing a secure online music distribution system including a media licensing mechanism as well as a payment mechanism to allow online purchasing of digital media (Se: Wiser et al. Figures 6A-6B). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the combination of Desai et al. and Schultz by further incorporating the online music distribution teachings of Wiser et al. because that would have enhanced the versatility of Desai's et al. image retrieval method by allowing it to be applied in an electronic commerce environment.

Remarks

The Applicant argued, "Desai does not disclose or suggest identifying a lowest-level term that subsumes queries in a grouping of search requests". The Examiner respectfully disagrees with the preceding argument because Desai achieves the aforementioned claimed feature by providing a graphical based image retrieval system (See Desai et al. Abstract, Col. 2, lines 22-38; Col. 4, lines 34-60; Col. 5, lines 56-63) wherein a categorization is applied on the content of the images in the database including an image retrieval system that allow a user to enter a query as an image and the query is ordered in a grouping of search queries by the retrieval system through a clustering methodology in which images (queries) that have similar characterizations are identified (See Desai Col. 2, lines 22-38).

The Applicant also argued, "applicants respectfully disagree that Voorhees discloses the amended limitation of applying a statistical clustering algorithm to the logged search requests, thereby grouping similar search requests together, as that limitation is used in the amended independent claims. Voorhees discloses training the computer for each search engine by clustering training queries and building cluster cancroids." (Voorhees, col. 2, lines 29-30.) Such training queries do not disclose or suggest applying a statistical clustering algorithm to logged search requests for which a user has expressed interest in a selected digital media record, as required by original independent Claim 10 and now clarified independent Claims 1, 4, and 7". However, it seems that the Applicant had partially considered the Voorhees reference (only col. 2, lines 29-30) while the Office Action indicated that the claims "Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai et al. U.S. Patent no. 6,0.72,904 in view of Schultz U.S. Patent no. 5,721,902 and further in view of Voorhees et al. U.S. Patent no. 5,864,845". From the above, the entire Voorhees et al. U.S. Patent no. 5,864,845 should be consider, and that Voorhees et al. U.S. Patent no. 5,864,845 does disclose the claimed feature of applying a statistical clustering algorithm to the logged search requests, thereby grouping similar search requests together by forming a single link list of search results (See Voorhees (Col. 1, lines 60-65) and the method utilizes a particular application of algorithms developed to combine the results of searched on potentially disjoint databases (See Voorhees Col. 2, lines 5-16). Therefore, Voorhees is clear on the disclosure of the claimed feature of applying a

statistical clustering algorithm to the logged search requests, thereby grouping similar search requests together.

Last, the applicant argued, Applicants also respectfully disagree that one of ordinary skill would have been motivated to combine Desai and Voorhees. The OA indicates that the motivation would be to provide a search retrieval system for combining the results of separate search engines into a single integrated ranked list of pages in response to a query. Desai requires that the retrieval system characterizes edge content of the target image, using the same techniques employed to characterize the images in the database." (Desai, col. 2, lines 26-28.) Thus, the uniform retrieval system is needed. In contrast, Voorhees is directed to an automatic method for facilitating World Wide Web Searches by exploiting the differences in the search results of multiple search engines "(Voorhees, col. 1, lines 8-10.) Thus, different retrieval systems are needed. Further, Desai states that this invention is premised on the assumption that the advantages gained by the increased speed of retrieval outweigh the disadvantages caused by a potentially erroneous retrieval." (Desai, col. 4, lines 4-6.)

In contrast, Voorhees states that its purpose is to produce a single list that is more accurate than any of the individual lists from which it is built. "Voorhees, col. 1, lines 10-12.) Modifying either reference by combining with the other reference would render each unsatisfactory for its intended purpose. (See MPEP 2143.01.) Thus, one of ordinary skill would not be motivated to combine Desai and Voorhees." The Examiner respectfully submits, the fact that applicant has recognized another advantage which

would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Further, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, It would have been obvious to one of ordinary skill in the art at the time of the invention to further modified the combination to Desai and Shultz above by incorporating the mechanism for query clustering disclose by Voorhees into the combined searching/retrieval system of Desai/Schultz. The motivation being to provide a search retrieval system for combining the results of separate search engines into a single integrated ranked list of pages in response to a query. Thereby, improved the effectiveness of a single text retrieval system despite the collection being physically separated (See Voorhees Col. 1, line 60-Col. 2, line 22).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is 571 272 4017. The examiner can normally be reached on Monday-Friday 9:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571 272 4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FRANTZ COBY
PRIMARY EXAMINER

June 23, 2006